

REMARKS

Claims 1-30 are pending. Claims 1, 15-28, and 30 have been amended. No new matter has been introduced. Reexamination and reconsideration of the present application are respectfully requested.

In the March 10, 2004 Office Action, the Examiner rejected claims 1-30 under 35 U.S.C. §112, ¶2, for being indefinite. Applicants have amended claims 1, 15, 27, and 30 to overcome this rejection.

The Examiner rejected claims 1, 5, 6, 10, 15, 19, and 30 under 35 U.S.C. §103(a) as being obvious over Leyda, U.S. Patent No. 5,867,730 ("Leyda"), in view of U.S. Patent No. 6,263,387 to Chrabaszcz ("Chrabaszcz") further in view of Thambidurai (Internet Printing). Claims 27 and 28 were rejected under 35 U.S.C. §103(a) as being obvious over Chrabaszcz in view of U.S. Patent No. 6,301,012 to White ("White") further in view of Thambidurai. Claim 29 was rejected under 35 U.S.C. §103(a) as being obvious over Chrabaszcz in view of a combination of White and Thambidurai, further in view of applicants' Admitted Prior Art ("APA"). Claims 2, 3, 11, 16, 17, and 22 were rejected under 35 U.S.C. §103(a) as being obvious over Leyda in view of Chrabaszcz and Thambidurai further in view of U.S. Patent No. 5,822,565 to DeRosa Jr. et al. ("DeRosa"). Claims 4 and 18 were rejected under 35 U.S.C. §103(a) as being obvious over Leyda, in view of Chrabaszcz, Thambidurai, and DeRosa, further in view of White. Claims 7-9, 12-14, 20, 21, and 23-26 were rejected under 35 U.S.C. §103(a) as being obvious over Leyda in view of Chrabaszcz, Thambidurai, and DeRosa, further in view of APA. These rejections are respectfully traversed.

Embodiments of the present invention relate to a method of configuring a computer for installation of a peripheral device. A print server is prepared to retrieve a first device identification from a memory of the peripheral device. The print server, the peripheral device, and the computer are connected via a computer network. The print server is directly connected to the computer, and the peripheral device is indirectly connected to the computer. The first device identification is compared to device names on a list of names associated with device drivers, and the list and the drivers are stored in a memory of the computer. An associated driver is selected for use if the first device identification matches one of the names. At least a portion of a routine for the preparing, comparing, and selecting operations is stored in a memory of the computer.

Independent claim 1, as amended, recites (with emphasis added):

A method of configuring a computer for installation of a peripheral device, the method comprising:

preparing a print server to retrieve a first device identification from a memory of the peripheral device, the print server, the peripheral device, and the computer being connected via a computer network, wherein the print server is directly connected to the computer, and the peripheral device is indirectly connected to the computer;

comparing the first device identification to device names on a list of names associated with device drivers, the list and the drivers being stored in a memory of the computer; and

selecting for use an associated driver if the first device identification matches one of the names, wherein at least a portion of a routine for the

preparing, comparing, and selecting operations is stored in a memory of the computer, and at least a portion of the routine for the preparing, comparing, and selecting operations is stored in a memory of the print server.

The Examiner rejected claims 1, 5, 6, 10, 15, 19, and 30 under 35 U.S.C. §103(a) as being obvious over Leyda, in view of Chrabaszcz, further in view of Thambidurai (Internet Printing). In so doing, the Examiner stated “Leyda teaches a computer connected to a peripheral device (computer 10, keyboard, peripheral devices; col. 2, line 42-col. 3, line 10), preparing the computer to retrieve a first device identification from a memory of the peripheral device (The FINDCD.SYS...including a vendor identification and model number for the CD_ROM driver; col. 6, lines 35-54), comparing the first device identification to device names on a list of names associated with device drivers (with the unique identification... driver type; col. 7, line 30-col. 8, line 31), the list and the drivers being stored in a memory of the computer (the system 100 includes ... software drivers files 104 ... loads the corresponding software ... driver files 104; col. 5, line 20 – col. 6, line 22), and selecting for use an associated driver if the first device identification matches one of the names, wherein at least a portion of a routine for the preparing, comparing, and selecting operations is stored in a memory of the computer.” (Emphasis added).

The Leyda reference does not disclose, teach, or suggest a method of configuring a computer for installation of a peripheral device as specified in amended independent claim 1. In fact, unlike the system specified in amended claim 1, the Leyda reference teaches away from the present invention and does not show a method

for **“preparing a print server to retrieve** a first device identification from a memory of the peripheral device, the print server, the peripheral device, and the computer being connected via a computer network, wherein the print server is directly connected to the computer, and **the peripheral device is indirectly connected to the computer”**.

Independent claim 1, as amended, requires (a) **“preparing a print server to retrieve** a first device identification from a memory of the peripheral device”, (b) **“the peripheral device is indirectly connected to the computer”**, and (c) “at least a portion of a routine for the preparing, comparing, and selecting operations is stored in a memory of the computer, and at least a portion of the routine for the preparing, comparing, and selecting operations is stored in a memory of the print server.”

The Examiner stated that “Leyda teaches a computer connected to a peripheral device (computer 10, keyboard, peripheral devices; col. 2, line 42-col. 3, line 10), preparing the computer to retrieve a first device identification from a memory of the peripheral device”. Leyda does not contemplate the use of a computer, a print server, and a peripheral device where the computer is directly connected to the print server, and the peripheral device is indirectly connected to the computer. Leyda teaches only one computer, a personal computer, directly connected to a peripheral device. Leyda does not even mention two computers (a computer and a print server). Therefore, Leyda does not teach (a) **“preparing a print server to retrieve** a first device identification from a memory of the peripheral device”, (b) **“the peripheral device is indirectly connected to the computer”**, and (c) “at least a portion of a routine for the preparing, comparing, and selecting operations is stored in a memory of the computer,

and at least a portion of the routine for the preparing, comparing, and selecting operations is stored in a memory of the print server.”

Moreover, it is respectfully submitted that it would not have been obvious to one skilled in the art to combine the teachings of the Lyda reference and the Charabaszcz reference, in view of the Thambidurai reference as suggested by the Examiner. It is well settled that a reference must provide some motivation or reason for one skilled in the art (working without the benefit of applicant's specification) to make the necessary changes in the disclosed device. The mere fact that a reference may be modified in the direction of the claimed invention does not make the modification obvious unless the reference expressly or implicitly teaches or suggests the desirability of the modification. In re Kotzab, 55 U.S.P.Q.2d 1313, 1317-18 (Fed. Cir. 2000); In re Fitch, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992); In re Mills, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990).

Furthermore, references cannot be combined where a reference teaches away from their combination, MPEP § 2143.01 (proposed modification cannot render prior art unsatisfactory for its intended purpose or change the principle of operation of a reference). It is improper to combine references where the references teach away from their combination. In re Grasselli, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).

The cited references, i.e., the Lyda reference, the Charabaszcz reference, and the Thambidurai reference, fail to meet the basic requirement for a finding of obviousness established by the courts in Kotzab, Fitch, and Mills. There is no suggestion in any of the three references of modifying the computer system disclosed in the Leyda reference in the direction of the present claim, i.e., (a) “**preparing a print**

server to retrieve a first device identification from a memory of the peripheral device”,
(b) **“the peripheral device is indirectly connected to the computer”**, and (c) “at least a portion of a routine for the preparing, comparing, and selecting operations is stored in a memory of the computer, and at least a portion of the routine for the preparing, comparing, and selecting operations is stored in a memory of the print server” nor is there any suggestion of the desirability of such modification.

Based on the Applicants' specification and claims, the Examiner is combining different references which are unrelated to each other, and none of which contains any teaching to be combined with each other.

The Leyda reference explicitly teaches a personal computer directly connected to a peripheral device (CD-ROM). The Leyda reference never states that the personal computer is directly connected to a second computer (a print server) and that the print server is **prepared to retrieve** a first device identification from a memory of the peripheral device, **the peripheral device is indirectly connected to the computer**, at least a portion of a routine for the preparing, comparing, and selecting operations is stored in a memory of the computer, and at least a portion of the routine for the preparing, comparing, and selecting operations is stored in a memory of the print server.

The Examiner in hindsight, working with the benefit of the Applicants' specification and claims, states “Leyda does not teach a print server...Charabaszcz teaches a server”. However, Charabaszcz does not disclose, teach, or suggest a method of configuring a computer for installation of a peripheral device, including (a) **“preparing a print server to retrieve** a first device identification from a memory of the

peripheral device”, (b) “**the peripheral device is indirectly connected to the computer**”, and (c) “at least a portion of a routine for the preparing, comparing, and selecting operations is stored in a memory of the computer, and at least a portion of the routine for the preparing, comparing, and selecting operations is stored in a memory of the print server.” This is a significant distinction over a mere network having a print server. Specifically, according to claim 1, as amended, the computer is configured for installation of a peripheral device even though the peripheral device is only indirectly connected to the computer (i.e., there is no direct connection). Therefore independent claim 1, as amended, distinguishes over Chrabaszc.

Independent claim 1 further distinguishes over Chrabaszc. Specifically, independent claim 1, as amended, further specifies that the first device identification is (a) *compared* to device names on a list of names associated with device drivers, the list and the drivers being stored in a memory of the computer; and (b) an associated driver is *selected* for use if the first device identification matches one of the names, *where at least a portion of a routine for the preparing, comparing, and selecting operations is stored in a memory of the computer, and at least a portion of the routine for the preparing, comparing, and selecting operations is stored in a memory of the print server.*

Chrabaszc does not disclose such a routine or that a portion of the routine is stored in a memory of the computer. According to previous installation methods, an installation routine would normally be stored directly in the print server itself, and the memory of the computer would not store at least a portion of the routine. By storing at least a portion of the routine in a memory of the computer, it is much easier for the user

to monitor the installation than would be possible if the routine was instead only installed on the print server. Therefore, independent claim 1, as amended, distinguishes over Chrabaszcz.

The Thambidurai reference does not make up for the deficiencies of the Leyda reference and the Chrabaszcz reference. The Thambidurai reference does not show (a) **preparing a print server to retrieve** a first device identification from a memory of the peripheral device”, (b) **the peripheral device is indirectly connected to the computer**”, and (c) at least a portion of a routine for the preparing, comparing, and selecting operations is stored in a memory of the computer, and at least a portion of the routine for the preparing, comparing, and selecting operations is stored in a memory of the print server.

Accordingly, Applicants respectfully submit that independent claim 1, as amended, distinguishes over the above-cited reference. Claims 2-14 all depend, directly or indirectly, from amended independent claim 1. Therefore, Applicants respectfully submit that claims 2-14 distinguish over the above-cited reference for the same reasons as set forth above with respect to amended independent claim 1.

Independent claims 15, and 30 recite limitations similar to amended independent claim 1. Specifically, claims 15 recites **the at least one printer is indirectly connected to the computer**, and at least a portion of a routine for the comparing and selecting operations is stored in a memory of **the computer**, and at least a portion of the routine for the comparing and selecting operations is stored in a memory of **the print server**. Claim 30 recites transmit instructions to a print server to **prepare the print server to retrieve** a first device identification from a memory of the peripheral

device connected to the print server, **the peripheral device is indirectly connected to the computer**. Therefore, independent claims 15, and 30 also distinguish over the above-cited reference for the same reasons as set forth above with respect to amended independent claim 1.

Claims 16-26 all depend, directly or indirectly, from amended independent claims 15. Therefore, Applicants respectfully submit that claims 16-26 distinguish over the above-cited reference for the same reasons as set forth above with respect to amended independent claim 1.

Independent claim 27, as amended, recites (with emphasis added):

A method of installing printer drivers in a computer of a computer system, the computer system also including a printer and a print server, the computer, the printer, and the print server being connected via a computer network, wherein the print server is directly connected to the computer, and the printer is indirectly connected to the computer, the method comprising:

preparing the print server to determine if a current installation of the printer drivers is a first installation of the printer drivers;

installing the printer drivers in the computer if the current installation is the first installation and storing information associated with the current installation in a memory of the print server;

retrieving information associated with the first installation from the memory only if the current installation is not the first installation, the information associated with the first installation including a first identification data string;

retrieving a current identification data string from a memory of the printer connected to the computer via the computer network, the current identification data string being associated with the current installation;

comparing the first identification data string with the current identification data string; and

installing the printer drivers in the computer based upon the information associated with the first installation only if the first identification data string matches the current identification data string, wherein at least a portion of a routine for the preparing, comparing, and installing operations is stored in a memory of the computer, and at least a portion of the routine for the preparing, comparing, and installing operations is stored in a memory of the print server.

Claims 27 and 28 were rejected under 35 U.S.C. §103(a) as being obvious over Chrabaszcz in view of White, further in view of Thambidurai. The Chrabaszcz reference does not disclose, teach, or suggest a method of installing printer drivers in a computer of a computer system, the computer system also including a printer and a print server as specified in amended independent claim 27. Unlike the method specified in amended claim 27, the Chrabaszcz reference teaches away from the present invention and does not show a method for **“installing the printer drivers in the computer** if the current installation is the first installation and storing information associated with the current installation in a memory of the print server” and “wherein at least a portion of a routine for the preparing, comparing, and installing operations is **stored in a memory of the computer**, and at least a portion of the routine for the

preparing, comparing, and installing operations is stored in a memory of **the print server**".

The Chrabaszc reference teaches that the print drivers are installed by the server. The Chrabaszc reference makes no mention whatsoever of **installing the printer drivers in the computer** separate from the server. The Chrabaszc reference makes no mention whatsoever of at least a portion of a routine for the preparing, comparing, and installing operations is **stored in a memory of the computer**, and at least a portion of the routine for the preparing, comparing, and installing operations is stored in a memory of **the print server**.

White does not make up for the deficiencies of Chrabaszc. The Examiner stated that White discloses preparing a print server to determine if a current installation of the print drivers is a first installation of the printer drivers, and installing the printer drivers in the computer based on the information associated with the first installation.

However, White does not disclose, teach, or suggest a method of configuring a computer for installation of a peripheral device, including **installing the printer drivers in the computer** separate from the server. The White reference makes no mention whatsoever of at least a portion of a routine for the preparing, comparing, and installing operations is **stored in a memory of the computer**, and at least a portion of the routine for the preparing, comparing, and installing operations is stored in a memory of the **print server**. Instead, White discloses that installation routines for installing a printer are stored entirely within a memory of a print server. [Col. 3, lines 16-26.] The White reference states "if the peripheral device is a new device on the network or a driver for the peripheral device is not registered on the server node, **the server node**

self-installing the driver for the peripheral device. Thus, newly connected peripheral devices are automatically seen on a network and **a driver for the peripheral device is automatically configured on a server node without any user intervention.**" [Col. 2, lines 15-23.] Therefore, independent claim 27, as amended, distinguishes over White.

The Thambidurai reference does not make up for the deficiencies of the White reference and the Chrabaszcz reference. The Thambidurai reference does not show **installing the printer drivers in the computer** separate from the server. The White reference makes no mention whatsoever of at least a portion of a routine for the preparing, comparing, and installing operations is **stored in a memory of the computer**, and at least a portion of the routine for the preparing, comparing, and installing operations is stored in a memory of the **print server**.

Accordingly, independent claim 27, as amended, distinguishes over Chrabaszcz, alone or in combination with any of White, and Thambidurai.

Claims 28 and 29 depend directly from independent claim 27, as amended, and therefore also distinguish over Chrabaszcz, White, and Thambidurai, alone or in combination, for the same reasons as those set forth above with respect to independent claim 27, as amended. Accordingly, Applicants respectfully submit that the rejection of claims 27-29 under 35 U.S.C. §103(b) should be withdrawn.

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Applicants believe that the foregoing amendments place the application in condition for allowance, and a favorable action is respectfully requested. If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call either of the undersigned attorneys at the Los Angeles telephone number (213) 488-7100 to discuss the steps necessary for placing the application in condition for allowance should the Examiner believe that such a telephone conference would advance prosecution of the application.

Respectfully submitted,

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